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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/593,645      06/13/00      MANICO      J      81254F-P

001333  
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GM12/1003

EXAMINER

HENDERSON, M

ART UNIT

PAPER NUMBER

3722

DATE MAILED:

10/03/01

3

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/593,645

Applicant(s)  
Manico et al

Examiner  
Mark T. Henderson

Art Unit  
3722



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above, claim(s) 35-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 and 44-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Jun 13, 2000 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 20) ☐ Other:

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## **DETAILED ACTION**

### **Faxing of Responses to Office Actions**

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXING of responses to Office Actions directly into the Group at (703)305-3579. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

### ***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-34 and 44-47, are drawn to an integral image product, classified in class 283, subclass 67.
- II. Claims 35-43, are drawn to a method of making an image product, classified in class 53, subclass 117.

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1. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the fold line can be formed by using a line of perforations or slits.

2. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Attorney Frank Pincelli on September 24, 2001 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-34 and 44-47. Affirmation of this election must be made by applicant in replying to this Office action. Claims 35-43 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

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### *Specification*

5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: In Claim 34, applicant is claiming that an “emboss line is provided on said leaf in association with said opening for allowing the leaf to be installed”. However, the specification and drawings disclose that a “scored line” is used in association with the opening for allowing leaf to be removed or installed. According to the specification and drawings, an “emboss line” is only used for folding purposes and has been treated as such in this office action.

### *Claim Objections*

6. Claims 21 and 22 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 21 and 22 are identical to Claims 2 and 3.

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*Drawings*

7. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: References "69", "96", "146 and 148" are not shown in the drawings. Correction is required.

*Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 12-14, 34 and 45-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
9. Claim 12 recites the limitation "the ends" in line 2. There is insufficient antecedent basis for this limitation in the claim.
10. Claim 13 recites the limitation "said abutting section" in line 3. There is insufficient antecedent basis for this limitation in the claim.

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11. Claim 14 recites the limitation "the ends" in line 2. There is insufficient antecedent basis for this limitation in the claim.

12. Claim 34 recites the limitation "one emboss line is provided on said leaf in association with said opening for allowing the leaf to be installed" in line 2. There is insufficient antecedent basis for this limitation in the claim. However, the examiner will interpret this claim limitation as an embossed line used for folding purposes.

13. Claim 45 recites the limitation "said dual sided integral composite image product" in line 5. There is insufficient antecedent basis for this limitation in the claim.

14. Claim 47 recites the limitation "said first and/or second substrate" in line 5. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 1-33 and 44-47, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Manico et al (5,791,692) in view of Hambright (6,164,859).

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Manico et al discloses in Fig. 1-6, an image product comprising a first support substrate (36) having a separate image layer (15-19) thereon, a second support substrate (38) having a separate image layer (21-25) thereon, wherein the second support substrate is secured to the first support substrate (Fig. 4 and 5) so as to form a dual sided image product, and wherein the first and second substrates are made from a photographic media, a thermal media and a photographic paper; and wherein the image layer comprises a photographic emulsion layer.

However, Manico et al does not disclose an image product having: a fold line or a plurality of fold lines about which the image product may be folded into numerous sections; image product folded in a Z-type fold; a cover for holding at least one leaf and a free standing product; wherein the numerous sections comprise a first, second and central section; wherein the side sections cover the central section; an attaching member comprising a ring to secure leaf or leaves with an opening to the cover.

Hambright discloses in Fig. 1-8, an image product (14) comprising a fold line (104) in which the image product can be folded in numerous sections (62 and 64) and wherein the image product also contains a cover (12) or free standing product for holding the image product (14), an attaching member consisting of a ring (48) to secure the image product to the cover, and an opening in the leaf (66A) to secure the leaf to the ring.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Manico et al's image product to include fold lines to divide



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product into numerous sections or panels as taught by Hambright for the purpose of providing a panoramic display of articles.

In regards to **Claims 2, 3, 10, 21, 22 and 47**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include as many fold lines and sections as desired, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

In regards to **Claims 3, 12, 13, 22**, it is notoriously well known to use a Z-fold to fold an article, since applicant has not disclosed that a Z-fold type solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with any type of fold.

In regards to **Claim 11**, it would have been an obvious matter of design choice to construct the sections in any desirable size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

16. Claim 34, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Manico et al in view of Hambright as applied to claims 29-33 above, and further in view of Fabel (5,836,622).

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Manico et al as modified by Hambright discloses an image product comprising all the elements as set forth in Claims 29-33, and as set forth above. However, Manico et al does not disclose an emboss line.

Fabel discloses in Col. 6, Lines 21-26, an image product having embossed lines used for folding an article.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Manico et al's and Hambright's image product to include embossed lines as taught by Fabel for the purpose of providing an uncut fold line.

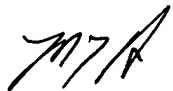
#### ***Prior Art References***

The prior art references listed in the attached PTO-892, but not used in a rejection of the claims, are cited for (their/its) structure. Eisen, Buraczynski, Bakke et al, Applebaum et al, Tan, Ohtake et al, Viesturs et al disclose an image product. Feldman et al discloses an attachment member.

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**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, A. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)305-3579. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

September 27, 2001



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